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09/652,793	08/31/2000	Michael L. Giniger	010079-004	2996

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EXAMINER

CHOW, CHARLES CHIANG

ART UNIT	PAPER NUMBER
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2684

DATE MAILED: 08/23/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/652,793

Applicant(s)

GINIGER ET AL.

Examiner

Charles Chow

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-3, 24-35, 36--47, 48-52 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**Detailed Action**

***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. § 112:
  - I. Claims 1-2 are, drawn to method and system of the mobile user and central cite server, classified in class 455, subclass 456.
  - II. Claims 3-23, and claims 48-52 are, drawn to mobile communication device's details for the receiver, processor, input device, and modulator/demodulator, classified in class 455, subclass 550.
  - III. Claims 24-35 are, drawn to details of the details for the interface for receiving, storage device, and method for server, classified in class 455, subclass 560.
  - IV. Claims 36-47 are, drawn to receiving/delivering link between mobile device and the server associated with the menu selection of the topics of interest, classified in class 455, subclass 424.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions [I], [II], [III], [IV] are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05 (C)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the subcombination for the system/wireless mobile terminal in claim 2 has the separate distinct utility in claim 1. The details in claims 3-23, 48-52, for the mobile terminal which comprises the distinct subcombination, the receiver,

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processor, input device, and mod./demod. The details in claims 24-35 comprises the distinct subcombination for the interface and method for server. The claims 36-47 comprises the distinct subcombination of message receiving/delivering link associated with the topics of interest.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48 (b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48 (b) and by the fee required under 37 C.F.R. § 1.17 (h).
5. During a telephone conversation with Finnan on 8/16/02, via primary examiner, a provisional election was made without traverse to prosecute the invention of II, claims 3-23, 48-52. Affirmation of this election must be made by applicant in replying to this Office action. Claim 1-2, 24-47, withdrawn from further consideration by the examiner, 37 C.F.R. 1.142(b), as being drawn to a nonelected invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the

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manner in which the invention was made.

6. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta et al. (US 5,025,261) in view of Delorme et al. (US 5,802,492).

Regarding **claim 3**, Ohta discloses a mobile communication device (vehicle 10, Fig. 1, Fig. 2a, abstract) for communication with a server (key station 20, Fig. 1, Fig. 2b, abstract) over communication network (network and system in Fig. 1; the 800-900 MHz in col. 5, lines 37-39; the vehicle 10 comprises the radio transceiver 105 and 105 could be portable telephone, MCA personal transceiver, col. 4, lines 18-26). Ohta discloses the mobile object determines the current position, transmits position data to key station, and receiving database retrieved map data information from key station (abstract).

Ohta discloses the receiver configured to receive position signals (GPS receiver 102, Fig. 2a). Ohta discloses the processor coupled to said receiver (Fig. 2a, it shows the coupled signal-composition-circuit 107, image processing unit 110, the comparator 108, and the identification signal generator 103, the GPS receiver 102 coupled to 104, 109) for responding to the position signals to determine position information indicative of a present position of the mobile communication device (abstract, and details in col. 9, lines 19-37).

Ohta discloses a modulator/demodulator (signal composition circuit 104/signal separation circuit 107, Fig. 2a) configured to transmit the position information signal to server (key station) over the communication network (as shown above) to receive position related information from the server (as shown above), wherein the position related information (map

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data) is a function of the position information. Regarding the selection signal, referring to Delorme below.

Ohta does not clearly indicate the input device and the operator selection.

Delorme teaches input device configured to receive from an operator selection signal indicative of a topic of interest (the input from the keyboard 110, col. 12, line 33; for the computer aided routing and positioning system, col. 12, lines 22-41; col. 12, line 60 to col. 13, line 4). The position related information, point-of-interest POI, displayed on screen is for user to select the POI in abstract, Fig. 1b-1D; col. 15, lines 61-67; col. 16, lines 26-30; col. 16, lines 44) using GPS system (col. 5, line 9; col. 12, line 37) for obtaining the current vehicle position (abstract). Beside, Delorme's input device could be the voice recognition system (col. 12, lines 57-60). Delorme's point-of-interest information for the current vehicle position could be the restaurants, hotel, cities, municipalities, airport, hospital, zoos, museums (col. 8, lines 13-21), and the computer could be portable laptop, or personal digital assistant PDA (col. 12, line 57 to col. 13, line 4).

Delorme also teaches the driver in the vehicle on the road for browse the position related information for restaurant in Seattle (col. 17, line 66 to col. 18, line 9). Delorme teaches the retrieved menu from system is displayed for user to select the POI using buttons (Fig. 1B-1D, col. 16, lines 24-44). The position related information is a function of the vehicle current position for a restaurant in Seattle. It is apparently obvious to include Delorme's input device to allow user to select the POI for the received menu, to Ohta. By doing so, the system could

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be upgraded to allow user to select the desire point-of-interest based on the current vehicle location. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify and add Delorme's input keypad/button and POI selection for the received menu, to Ohta as modified above, such that system could be upgraded to allow user to select the point-of-interest based on the current location.

Regarding **claim 4**, referring to examiner's comment from Delorme above, from the plurality of point-of-interest POIs (abstract).

Regarding **claim 5**, referring to examiner's comment from Ohta in claim 1 for the GPS receiver 102 for the vehicle 10's navigation apparatus 100.

8. Claims 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Delorme, and further in view of Wang et al. (US 5,365,451).

In the above, it does not indicate clearly enough for the details of periodically update in the network.

Regarding **claim 6**, Wang teaches the processor periodically determines the position information from position signals received (abstract, Fig. 1-9) by said receiver (receiver in mobile 16, Fig. 2) and said modulator/demodulator periodically transmits the position information to the server (the mobile unit determine their current locations from GPS satellite, front figure, Fig. 1, abstract; the repetitively determine their current location in a regular schedule; the update location data maintain in the network, in abstract; col. 1, lines 9-12; col. 9, line 54 to col. 10, line 5). The comparing time stamp and transmit current location (Fig. 6,

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steps 102, 104, 79). It is apparently obvious to include Wang's repetitively updating and determining the current position and update the position information maintain in the network, to Ohta. By doing so, the system could maintain the most updated position information for providing the efficient service. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify and add Wang's determining current position, and update the position information maintain in the network, to Ohta as modified above, such that system could maintained the most updated position information for providing the efficient service.

Regarding **claim 7**, referring to examiner's comment in claim 6 above for the periodically update with a refresh interval using Wang's time stamp step 102, 104.

Regarding **claim 8**, referring to examiner's comment from Delorme for the alphanumeric keypad input entry device.

9. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Delorme, and further in view of Khamis et al. (US 5,930,729).

In the above, it does not clearly indicate the DTMF.

Regarding **claim 9**, Khamis teaches a dual tone multiple frequency DTMF generator 161 (Fig. 4B) responsive to the alphanumeric entry to supply a DTMF selection signal to said modulator/demodulator (mixer 155, the demodulator mixer amp 182, in Fig. 4B). It is apparently obvious to include Khamis's DTMF conversion for the cellular phone, to Ohta's modified system. By doing so, Ohta's system could be upgraded by efficiently using the



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available DTMF for encoding/decoding the alphanumeric input. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify and add Khamis' DTMF generator for encoding/decoding, to Ohta as modified above, such that the system could be upgraded for encoding/decoding the alphanumeric input.

Regarding **claim 10, 11**, referring to examiner's comment from Delorme above for the voice recognition system (col. 12, lines 57-58), the microphone coupled to the modulator (Khamis, Fig. 8) for transmitting audio signal to the server, and the microphone input, the voice recognition system for user selection of the POI from Delorme.

10. Claims 12-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Delorme, and further in view of Morimura et al. (Us 5,438,695).

In the above, it does not clearly indicate the microphone isolation circuit.

Regarding **claim 12**, Morimura teaches the microphone isolation circuit configured to disconnect an output of said microphone from said mod./demod. during reception (the cellular telephone used in the transceiver on/off operation having the microphone switch 16, ear receiver switch 15, for controlling (Fig. 3, steps 155, 157) the audio from microphone 18, to ear receiver 17 (speaker), to avoid the disruption to the ongoing voice conversation during the battery change. It is clearly obvious to include Morimura's switch control for the microphone/ear speaker to the cellular communication device to Ohta system. By doing so, Ohta's system would provide better voice transmission/receiving control, alike the regular push-to-talk device, the voice signal could avoid the interruption due to the transmission,

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receiving operation. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify and add Morimura's switches 16/15 for controlling microphone/ear speaker, to Ohta as modified above, such that the voice signal could avoid the interruption due to the transmission, receiving operation.

Regarding the reception of the position related information, referring to claim 3 above.

Regarding **claim 13**, referring to examiner's comment from Delorme for the audio output speaker 107 as shown in col. 13, line 62 to col. 14, line 4.

Regarding **claim 14**, referring to examiner's comment from Morimura for the speaker isolation circuit (switch 15 for ear receiver-speaker to isolate the speaker 17 from emanating).

Regarding **claim 15, 16**, referring to examiner's comment in claim 3 above for the modulator/demodulator, the wireless network, analog phone of 800-900 MHZ, MCA personal transceiver.

Regarding **claim 17**, referring to examiner's comment in claim 3 above for PDA of the digital wireless telephone (col. 12, lines 62-65 from Delorme).

Regarding **claim 18**, referring to examiner's comment in claim 3 above for the laptop computer (col. 12, line 65 from Delorme).

Regarding **claims 19, 20, 21, 22**, referring to examiner's comment from Delorme (col. 6, lines 10-19) that the received point of interest information could be audio, text, image, video signal.

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- 11 Claim 23, 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Delorme, and further in view of Thompson (US 5,109,399).

In the above, it does not clearly indicate the emergency response and forward position information.

Regarding **claim 23**, Thompson teaches the mobile comm. device is configured to send an emergency response to the server to cause the server to forward the position information to an emergency response system (the emergency call locating system, title; the displaying of the caller's location; the interface to private network, abstract, Fig. 4 with position related information, swimming pool, gasoline tank, C & O railroad). In col. 1, line 63 to col. 2, line 14, Thompson considers the map information could be distributed by serving operator, to other appropriate emergency service agencies, such as police, fire, or medical department, for a quick, positive rescue. It is apparently to be obvious for including Thompson's emergency locating of the caller and redistribute the map to other proper agencies, to Ohta, such that Ohta's system could efficiently sending the emergency location information to the appropriate agencies for help. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify and add Thompson's emergency response to send current mobile position to proper agencies, to Ohta as modified above, such that system could efficiently provide the help according to the emergency location.

Regarding **claim 48** referring to examiner's comment in claim 3 for the receiver; the process; the modulator/demodulator, the position report.

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13. Claims 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohta in view of Emmons (US 5,703,598).

In the above, it does not include the enabling, disabling the position reporting.

Regarding **claim 49**, Emmons teaches the position reporting enabling unit is an enable/disable switch (the timer 24 for controlling the switch circuit for enabling/disabling of the GPS receiver/transmitter for transmitting current location for the stolen vehicle or other property, abstract, front figure, col. 1, lines 4-10). Emmons considers the GPS transmitter is disabled by timer, but may be enabled by a subsequent signal from the central station with for additional period of time (col. 1, lines 58-63). It is apparently obvious to include Emmons' timer for automatic controlling of the GPS receiver/transmitter, to Ohta, such that the system could be upgraded with the automatic timer control for enabling/disabling of the GPS receiver/transmitter with efficiency. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify and add Emmons' timer 24/switch 22 for automatic controlling of the GPS receiver/transmitter, to Ohta as modified above, such that that the system could be upgraded with the automatic timer control for enabling/disabling of the GPS receiver/transmitter with efficiency.

Regarding **claim 50**, referring to examiner's comment in claim 7 for the periodically determining, the refresh interval.

Regarding **claim 51**, referring to examiner's comment from Emmons for the position

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reporting could be also enabled by central station to reset, override the refresh interval, as shown above, the central station could enable the GPS receiver/transmitter by a subsequent signal for additional period of time, as a reset override interval (col. 1, lines 58-63).

Regarding **claim 52**, referring to examiner's comment in claim 5 above, for the GPS receiver.

### ***Conclusion***

13. As per telephone conversation, August 16, 2002, the elected claims are 3-23, 48-52. Claims 1-2, 24-47, are restricted.

In the above discussion, Ohta discloses a mobile vehicle 10 for communication with a server, key station 20, over the 800-900 MHz MCA network for determining the current position, transmits position information to key station, and receiving database retrieved map data information from key station. Ohta discloses the GPS. Ohta discloses the processor coupled to signal-composition-circuit 107, image processing unit 110, the comparator 108, and the identification signal generator 103. The GPS receiver 102 coupled to 104/109 for responding to the position signals to determine the current position. Ohta discloses the signal composition circuit 104/signal separation circuit 107 for transmitting the position information signal to key station. Delorme teaches the input keypad/button and POI selection for the received menu. Wang teaches the Wang's determining current position, and update the position information maintained in the network. Khamis teaches the DTMF generator for encoding/decoding. Morimura teaches the switches 16/15 for controlling microphone/ear speaker. Thompson teaches the emergency response to send current mobile position to proper

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agencies. Emmons teaches the timer 24/switch 22 for automatic controlling of the GPS receiver/transmitter.

14. The cited pertinent prior arts are listed below:

- A. US 5,959,577, September 1999, Fan et al. discloses the distribution of travel information using network (title) for the reporting of the vehicle position and receiving the position related information, directions to gasoline station, from the network service (abstract).
- B. US 5,742,924, April 1998, Nakayama discloses the system for navigating the mobile body with the transmitted map information selected by the user, having the hierarchical level for the place of historic interest, lake, swamp, scenic spot (abstract, col. 6, lines 59-64; col. 8, lines 61-67).
- C. US 5,406,492, April 1995, Suzuki discloses the voice instruction guidance for the driver for the vehicle routing (abstract, col. 4, lines 58-62; col. 4, line 64 to col. 5, line 21).
- D. Auto update, July 1995, page 214, Daly discloses the satellite cellular rescue unit for instantly pinpoint the vehicle position for roadside assistance, medical, police, service.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Chow whose telephone number is (703)-306-5615.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel Hunter, can be reached at (703)-308-6732.

Any response to this action should be mailed to:

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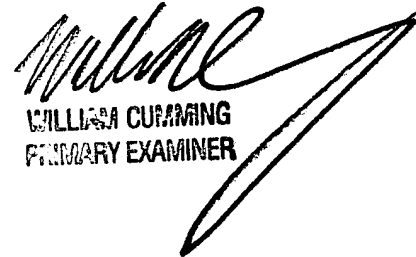
or faxed to: (703) 872-9314 (for Technology Center 2600 only)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
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Any inquiry of a general nature or relating to the status of this application or  
proceeding should be directed to the Technology Center 2600 Customer Service Office  
whose telephone number is (703) 306-0377.

Charles Chow

August 16, 2002.

  
WILLIAM CUMMING  
PRIMARY EXAMINER